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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/509,612 03/29/00 ABRIGNANI

S 0366.103

EXAMINER

HM12/0323

CHIRON CORPORATION
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PO BOX 8097
EMERYVILLE CA 94662-8097

WERTMAN, D ART UNIT	PAPER NUMBER
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1648
DATE MAILED:

03/23/01

Handwritten number 08.

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/509,612

Applicant(s)

Abrignani et al.

Examiner

Donna C. Wortman, Ph.D.

Group Art Unit

1648



☒ Responsive to communication(s) filed on Mar 20, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-26 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Claims 1-26 as originally filed are pending and subject to restriction.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-5, 8-13, 25 and 26, insofar as each claim is drawn to CD81 protein and compositions comprising CD81 protein.

Group II, claims 6, 8, 10, 11, insofar as each claim is drawn to a compound that binds CD81 protein and compositions comprising such compound.

Group III, claim 7, insofar as the claim is drawn to a method of treatment using CD81.

Group IV, claim 7, insofar as the claim is drawn to a method of treatment using a compound that binds to CD81.

Group V, claims 14-18, drawn to assay methods using CD81.

Group VI, claims 19 and 20, drawn to a transgenic animal carrying a CD81 transgene.

Group VII, claims 21-24, drawn to nucleic acids that encode CD81 protein.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for

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the following reasons: A common technical feature under PCT Rule 13 is defined by a shared contribution over the prior art. Oren et al. (Molecular and Cellular Biology 10(8):4007-4015, 1990), cited by Applicant as Reference C.15 on PTO 1449 submitted February 27, 2001, discloses the protein TAPA-1, which is the same protein as CD81. Consequently the claims of Group I do not make a contribution over the prior art that is shared by the claims of Groups II-VII. The products of Groups I, II, and VII are distinct compounds that necessarily differ in chemical properties. The inanimate compositions of Groups I, II, and VII are distinctly different from the animal of Group VI. The methods of Groups III, IV, and V are distinct methods having different goals and outcomes and requiring different products and process steps.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wortman whose telephone number is (703) 308-1032. The examiner can normally be reached on Monday through Thursday from 7:30 am to 5:00 pm. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached at (703) 308-4027. Any inquiry of a general

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nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Examiner Donna Wortman, Art Unit 1648, and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Art Unit 1648 FAX telephone number for official papers is (703) 308-4242. FAX machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday, or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.



Donna C. Wortman, Ph.D.
Primary Examiner

March 21, 2001